



PATENT
P56341

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

In re Application of:

Kenneth Buck ALBRITTON

Appeal No. _____

Serial No.: 09/995,615

Examiner: MAI, TRI M.

Filed: 29 November 2001

Art Unit: 3727

For: PORTABLE LOCKER BACKPACK (*as amended*)

Attn: Board of Patent Appeals & Interferences

REPLY BRIEF

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Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §41.41(a), Appellant hereby requests entry of this Reply Brief in response to the Examiner's Answer (unnumbered paper) mailed on 6 February 2006.

This Reply Brief is filed in triplicate, together with a written Request for An Oral Hearing before the Board of Patent Appeals and Interferences, and the statutory fee incurred by that request.

Folio: P56341
Date: 4/6/06
I.D.: REB/SS/sb

REMARKS

The Examiner's Answer (unnumbered paper) mailed on 6 February 2006 has been carefully considered.

A. Rejection of claims 41, 43, 45, and 46-53 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Regarding claim 41, the Examiner argues that is to say the back wall can be disposed upward in the hanging position. However, claim 41 is concerning the bag in the closed position as it states in line 8 "closing". The claim must be looked at as a whole. Therefore, looking at the claim as a whole, in order to close the bag, the back wall is folded frontally downwards toward the front portion to accommodate the fastening and closing of the bag as seen in figure 10 with the bag closed. Looking at the zipper and fastenings in figure 10 in the closed position and figure 8 in the open position, it can be seen that the folding would be as claimed.

Regarding claim 43, the Examiner states that the figures nowhere show the back wall being separate from other walls.

However, the back wall is separately referenced from the other walls in the specification and drawings. For example, paragraph includes sidewalls 724 and wall 722 while paragraph 38 includes back portion or wall 16. Moreover, paragraph 61 states for example, "Furthermore, because the material mesh 725 material is on the side walls, it is not so prone to being worn out as if it was on the front or back side of the bag. The side walls 724 extend from each side of the bottom portion

782 of the back wall 780 of the backpack 710 where the bottom portion 782 of the back wall 780 of the backpack 710 has a greater width than the top portion 784 of the back wall 780 of the backpack 710. The side walls 724 form angles with the extended portion 786 of the bottom back wall 782 of the backpack 710 accommodating a backpack that closes all sides which then stop any loose items that get out of the compartments 770 from being released from the bag 710.” The back wall 782 is separately referenced and discussed as in regards to the other walls.

In addition, the original claims mention the limitation of the backwall.

Furthermore, the Examiner’s argument that the back wall is not separate from the side walls and bottom walls does not affect the claim language that merely states “with said back wall folding to close said bag by folding the top portion of said back wall to the front edge of a bottom portion of said back wall to couple with said bottom portion formed from a bottom of said backwall, said left wall and said right wall extending from the bottom portion of said back wall and upwards from said bottom of said backwall forming a bottom of said backpack.”

B. Rejection of claims 41, 45-53 are rejected under 35 U.S.C. 112, second paragraph.

Regarding claim 41, the Examiner stated that recitation "said back wall being folded by the top portion of said back wall being folded" is confusing and furthermore, it is noted that claim 27 previously recited that the back wall is folded flat and claim 41 then recites that the back wall is folded only frontally downwards.

First of all, claim 27 is not related to claim 41 as they do not even depend on the same independent claims. The claim is detailing further how the back wall is folded as the top portion of

the backwall is folded only frontally downwards. The claims starts with “with said back wall being folded” and then elaborates as how it is folded by stating “by the top portion of the backwall being folded only frontally downwards towards...”

Regarding claim 46, the Examiner states that it is unclear how the back wall being separate from the other walls. However, as shown above in the remarks concerning claim 43 in the 35USC§112 (first paragraph) rejection in section “A”, the back wall can be claimed as seen in claim 46 as was claimed in claim 43.

C. Rejection of claims 35, and 37 under 35 U.S.C. 102(a) as being anticipated by Fournier.

The Examiner argues that the use of a second reference is allowable in a 35USC§102 anticipation rejection to establish inherency of the bag being carried on the back as a backpack.

The CCPA has added that “inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

Moreover, looking at figure 1 and 2 of *Fournier* '034, the portion the Examiner purposes to be used as a backpack has rounded and pointed back that would be highly undesirable for back transport of the backpack. Rather, *Fournier* '034 is designed for hand and over the shoulder support as mentioned in col. 4, lines 53-55, but there is no disclosure that it would be appropriate for back transport as a backpack since the formation in figures 1 and 2 show otherwise.

Therefore, one cannot say that *Fournier '034* inherently discloses the limitation as the opposite it true. Moreover, by having to use *Kiduff '414*, to show inherency, the Examiner is making an improper anticipation rejection.

MPEP §2131 quite clearly states, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

MPEP §2131 does mention that an extra reference or evidence can be used to show an inherent characteristic of the thing taught by the primary reference. However, to serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). However, merely showing that it is possible to have a strap be used as a backpack does not mean that it is clearly present in *Fournier '034* as figures 1 and 2's curved and pointed walls would make it difficult. Therefore, one cannot assume that it would be necessarily be present. The higher threshold of "necessarily" present has not been met by the Examiner.

D. Rejection of claims 39, 40, and 44 under 35 U. S.C. 102(a) as being anticipated by Tong.

Tong '519, like *Fournier '034* , also includes a hand strap and a curved wall that would

protrude against the back of a user if carried on the back of a user as a backpack. Therefore, again as in section “C” concerning *Fournier* ‘034, the use of *Kiduff* ‘414 does not necessarily present the feature described in the reference as mandated by MPEP §2131 when introducing a second reference in an anticipation rejection.

The reference of *Tong* ‘519 would have to be modified and therefore, the Examiner must provide a teaching or suggestion of modifying *Tong* ‘519. However, since an anticipation rejection was made, the rejection is improper.

E. Rejection of claims 24, 25, 26, and 32 under 35 U.S.C. 103(a) as being, unpatentable over Tong (6334519) in view of Fournier.

Regarding claim 24, the examiner submits that the pair of shoulder straps is disposed a predetermined distance from each other along the longitudinal side of the back surface and that the claim does not require each strap to extend individually along the longitudinal side of the back surface.

However, the claim specifically claims *a pair of straps disposed a predetermined distance from each other along the longitudinal side of a bottom portion of the back surface of said back wall to accommodate a carrying of said bag on the back of a user*. It is the pair of straps that a certain distance from each other *along* the longitudinal side and such is not taught or suggested.

F. Rejection of claim 38 under 35 U.S.C. 103(a) as being unpatentable over either the

Fournier or Tong rejection as set forth above, in view of Briggs et al. (2626689).

The Examiner states that in this case, one of ordinary skill in the art would recognize to provide straps of Briggs in either Fournier or Tong since all of these references pertain to the folding/hanging bags. However, this again is not a clear and particular suggestion or motivation to combine the references but a broad generalized statement.

Further, the Examiner has failed in providing substantial evidence under MPEP §2144.03, which includes procedures that the Examiner must take in providing substantial evidence when there is reliance on common knowledge in the art or “well known” prior art. The Examiner here by stating such is known in art has failed under the standards set under MPEP 2144.03.

G. Rejection of claim 38 under 35 U.S.C. 103(a) as being, unpatentable over either the Fournier or Tong rejection as set forth above, in view of Davis et al. (2626689).

The Examiner states that, it would have been obvious for one of ordinary skill in the art to provide the strap 52 in the folding bag of either Fournier or Tong for holding garments.

However, the suggestion or motivation needs to show accommodating the hanging along a length of the back wall specifically and not merely holding the garments alone. Since, such a motivation has not been clearly and particularly shown, then the obviousness rejection is improper.

H. Rejection of claims 24-27, 32, 35, 37, and 39-45 under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. (5575362) in view of Wulf et al. (5749503), and further in view of

Bomes et al. (5054589).

The examiner submits that the claim does not limit the straps being attached to the back wall.

However, claim 24 for example includes *a pair of straps disposed a predetermined distance from each other along the longitudinal side of a bottom portion of the back surface of said back wall to accommodate a carrying of said bag on the back of a user* and therefore is disposed on the back surface of the back wall.

The Examiner states that the straps of Wulf are disposed, or position, on the back wall, even though one end is not anchored on the back wall. However, as seen in figure 4, clearly the strap is disposed from the side wall to the back wall instead.

Furthermore, the Examiner states that Wulf even teaches a strap in the pack of 76 with two ends attached to the back panel of a backpack as it would have been obvious for one of ordinary skill in the art to provide this strap arrangement in Franklin.

However, it is not clear from pack 76 that it is not any different from the close-up of the pack of figure 4 as one portion is still looks to be disposed from the side wall.

In addition, the examiner submits the recitation of the hook 152 for hanging on an external object is an intended use and the examiner submits that the handle in Franklin is a retractable handle, and one would be able to utilize the hook while the retractable handle is not deployed.

However, as seen in figure 15 of Franklin, even if the handle is retracted, the thickness of the handle and the base portion 100 makes it difficult for the flange to be hanging on an external object.

As mentioned in MPEP §706.02(j), there must be a reasonable expectation of success and here there is not a reasonable expectation of success since it is clear that the flange is not designed for hanging on external objects but for holding the handle in place.

Regarding claim 35, the examiner submits that there is a compartment 94 on the back surface for holding the retractable handle and that claim 35 does not require the bottom compartment to be disposed on the front surface, furthermore, the examiner submits that Bomes teaches a plurality of compartments disposed on the back panel.

However, the claim does specifically state “front surface of the back wall.” Moreover, Bomes as seen in figure 6 fails to teach or suggest the compartments on a single plane from a top portion to the bottom portion.

I. Rejection of claims 24-27, 32, 35, 37, 39-48, 54, and 55 under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. in view of either Wulf et al. or Yu (6129254), and further in view of Fournier.

Claims 24-27, 32, 35, 37, 39-48, 54, and 55 include limitations beyond merely folding hanging bags and pockets as the Examiner mentions.

The PTO has the burden of proof, by a preponderance of the evidence, to show that an applicant is not entitled to a patent because the claimed subject matter is anticipated by, or is obvious from, the art of record. A patent applicant is entitled to a patent “unless” the PTO establishes

otherwise. See, e.g., *In re Dembiczak*, 175 F.3d 994, 1001, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999); *In re Epstein*, 32 F.3d 1559, 1564 (Fed. Cir. 1994); *In re Rijckeart*, 9 F.3d 1551, 1552, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The rejection provided by the Examiner must provide for each any every limitation.

Moreover, the Examiner is newly including the motivation to combine as he failed to earlier to provide such proof. In addition, the motivation to combine of “providing additional way to transport the luggage bag” is not clear and particular, but is a generalized statement. Therefore, the motivation to combine is improper.

Moreover, the Examiner should provide such motivation to combine in a timely manner for the Applicant to respond in a proper manner. Providing motivation at such a late date is then dismissing the Examiner’s burden and placing the Applicant at a disadvantage in the prosecution process. An applicant should not have to file an appeal in order to receive a complete response under 37CFR§1.104. In item 10 on page 5 of the final rejection of paper no. 20050207, the Examiner failed to provide a complete response to the rejection as only the netted compartments were discussed and no motivation to combine was provided.

J. Rejection of claims 24-27, 32, 34, 35, 37-48, 54-55 under 35 U.S.C. 103(a) with regard to the affidavit of commercial success.

The examiner submits that these evidences are insufficient to establish a nexus with the

claimed invention.

However, the Applicant asserts as shown in the appeal brief, the nexus has been shown with extensive proof.

As mentioned MPEP§716.03(b), a patentee does not have to prove that the commercial success is not due to other factors. "A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence."

The Examiner states that with respect to the various awards and press releases, there is no showing that these awards, and these press releases are made with any considerations with the prior art as applied above.

However, there is no requirement that the awards and press releases must be specifically with the applied prior art such as Kiduff or Fournier, etc. However, comments were made in the awards and press releases regarding what is known in the art.

Furthermore, the examiner submits that these awards and articles are made in view of the invention with all of the features of the disclosed invention and there is no evidence that these awards, press releases are made to a specific feature or a subgroup of features of the invention.

However, the Applicant did submit that the awards and press releases were related to the claimed invention as made in the sworn affidavit that such awards and press releases refer to claim 24. In fact, photographs of the submitted backpack were shown in some of the releases verifying

further the connection. The awards at the United Inventors Association for example refers to the Gearmax backpack and such a bag is provided in the affidavit in detail of the features of the GEARMAX bag in other sections which is commensurate in scope with the claimed invention. The Applicant submits that such a bag is commensurate with claim 24 which is rejected under 35USC§103 and the commercial success is derived from the claim invention. MPEP §716.03(a) and (b).

With respect to the sale receipts, the Examiner made a broad statement that the showing of the sale receipt is also insufficient to show a nexus between the claimed invention and commercial success.


The sales receipt are related to the claimed invention as it relates to the GEARMAX backpack, which has the features of the claimed invention. Furthermore, in the affidavit, it is submitted that the invoices of sales is respect to the invention as claimed in claim 24.

Moreover, not only were sales receipts provided, but also the evidence of increased market share was specifically provided. The specific showing of increased market share is a proof of nexus of commercial success.

Therefore, according to MPEP 716.03, commercial success commensurate in scope with claimed invention and commercial success derived from claimed invention has been shown in the affidavits of commercial success submitted by the Applicant through the plurality of evidence.

A Request for Oral Hearing and an Appellant's check in the amount of \$500.00 (Small Entity) drawn to the order of Commissioner accompany this Reply Brief. Should the Request and/or check become lost, the Commissioner is kindly requested to treat this paragraph as such a request, and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fee.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R. E. Bushnell", is written over a horizontal line.

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